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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,983	08/13/2001	Barry J. Gilhuly	1400-1072 P6	8317

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RESEARCH IN MOTION  
ATTN: GLENDA WOLFE  
BUILDING 6, BRAZOS EAST, SUITE 100  
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IRVING, TX 75039

EXAMINER
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STRANGE, AARON N

ART UNIT	PAPER NUMBER
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2453

NOTIFICATION DATE	DELIVERY MODE
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11/26/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

portfolioprossecution@rim.com

<b>Office Action Summary</b>	<b>Application No.</b> 09/928,983	<b>Applicant(s)</b> GILHULY ET AL.	
	<b>Examiner</b> AARON STRANGE	<b>Art Unit</b> 2453	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 175-181, 184-188, 190-198, 201-205, 207-215, 218-222, 224 and 225 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 175-181, 184-188, 190-198, 201-205, 207-215, 218-222, 224 and 225 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Priority***

1. Applicant's assertion that the "status of the present application as a CIP application is proper" (Remarks, 27) is noted. The Examiner agrees that the present application is a CIP application. However, as noted in the Office action of 5/23/2008 (§2), the claims of the present application are not supported by the disclosure of the prior filed applications, International Patent Application No. PCT/CA00/01108 (filed Sep. 25, 2000), U.S. Patent Application No. 09/401,868 (filed Sep. 23, 1999), and U.S. Patent Application No. 09/087,623 (filed May 29, 1998).

Accordingly, while the application may be a continuation-in-part of one or more of the prior filed applications, the claims of the present application are not entitled to an effective filing date as of the date any of the prior applications were filed. The effective filing date of all pending claims in the filing date of the present application, 8/13/2001.

### ***Specification***

2. Applicant's amendments to the specification are sufficient to overcome the objection to the specification set forth in the Office action of 5/23/2008 (§4).

### ***Claim Objections***

3. Applicant's amendments are sufficient to overcome the objection of claim 192 set forth in the Office action of 5/23/2008 (§5).

***Claim Rejections - 35 USC § 101***

4. Applicant's amendments are sufficient to overcome the rejection of claims 192-208 under 35 U.S.C. § 101, set forth in the Office action of 5/23/2008 (§6-8).

***Claim Rejections - 35 USC § 112***

5. Applicant's amendments are sufficient to overcome the rejection of claims 209-225 under 35 U.S.C. § 112, set forth in the Office action of 5/23/2008 (§9-12).

***Response to Arguments***

6. Applicant's arguments with 35 U.S.C. § 103(a) rejections (Remarks, 29-35) have been fully considered but they are not persuasive.

With regard to claims 175, and Applicant's assertion that Doonan "does not disclose or suggest sending a first encryption key from a computer system associated with the user to a redirector host system" (Remarks, 34-35), the Examiner respectfully disagrees.

Doonan teaches use of a key server that sends encryption keys to message "senders" and decryption keys to message "recipients" (col. 3, ll. 33-58) ), wherein the keys may be sent via secure connections (secure HTTP)(col. 3, ll. 40-42). Doonan discloses that the "senders" and "recipients" may be computers associated with users or software programs operating in an unattended "server mode" (col. 3, ll. 18-31). The addition of a key server to AirMobile's cc:Mail server would have provided encryption

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keys to the redirector host, decryption keys to the mobile device, and allowed messages to be encrypted to protect the messages from interception during transmission to the mobile device.

Additionally, the Examiner would like to note that claim limitations that merely specify the location where encryption keys are generated and how those keys are provided to the sending (redirector host) and receiving (mobile device) elements are not likely to patentably distinguish the claims from the prior art of record. One of ordinary skill in the art would have recognized that systems generating the keys at various locations would have been nothing more than predictable variations of each other. One of ordinary skill in the art would have been able to easily modify the system to generate encryption/decryption keys at any location within the system, and doing so would necessitate that the keys be provided to the redirector host and mobile device for use in encrypting the messages, regardless of the location at which the keys were generated.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 175, 178, 179-181, 184-188, 190, 192, 195, 196-198, 201-205, 207, 209, 212-215, 218-222 and 224 are rejected under 35 U.S.C. 103(a) as being unpatentable

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over AirMobile ("AirMobile Software of Lotus cc:Mail Wireless: Communication Server Guide") in view of Doonan et al. (US 6,807,277).

9. With regard to claim 175, AirMobile discloses a method of redirecting data items from a messaging host system to a user's mobile device, comprising:

detecting a new data item for the user at the messaging host system (cc:Mail Post Office server) by the redirector host system (AirMobile Wireless for cc:Mail server) (new messages are received at the post office server, and detected by the AirMobile server)(pp. 25-26);

determining whether the new data item should be redirected from the redirector host system to the user's mobile device (AirMobile server checks download filters to determine whether to forward the message to the mobile device)(p. 26);

if the new data item should be redirected; and

transmitting the new data item from the redirector host system to the user's mobile device (messages passing the download filters will be sent to the wireless device)(p. 26).

While AirMobile teaches the use of a "secure and authenticated" channel (p. 25), it fails to specifically disclose that encrypting the messages prior to transmitting them via the channel using encryption/decryption keys sent to the redirector host and mobile device (via a secure connection) by the computer system associated with the user.

Doonan discloses a similar system for transmitting electronic messages (Abstract). Doonan teaches use of a key server that sends encryption keys to message

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"senders" and decryption keys to message "recipients" (col. 3, ll. 33-58), wherein the keys may be sent via secure connections (secure HTTP)(col. 3, ll. 40-42). Doonan discloses that the "senders" and "recipients" may be computers associated with users or software programs operating in an unattended "server mode" (col. 3, ll. 18-31). The addition of a key server to AirMobile's system would have been advantageous since it would have provided encryption keys to the redirector host, decryption keys to the mobile device, and allowed messages to be encrypted to protect the messages from interception during transmission to the mobile device.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to encrypt the redirected messages prior to transmission to ensure that they were not intercepted by unauthorized recipients during transmission to the client.

10. With regard to claim 178, Doonan further discloses that sending the first encryption key and sending the first decryption key further comprise generating a shared key (keys may be symmetric) (col. 9, ll. 54-61).

11. With regard to claim 179, Doonan further discloses generating the first encryption key and the first decryption key according to a symmetric key encryption scheme (keys may be symmetric) (col. 9, ll. 54-61).

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12. With regard to claims 180 and 181, Doonan further discloses that the encryption/decryption keys comprise public and private keys (keys may be asymmetric) (col. 9, ll. 54-61).

13. With regard to claim 184, Doonan further discloses sending a second encryption key to the mobile device (a different encryption key is used by each sender, based on their credentials, so a different decryption key is needed for each message). (col. 3, ll. 32-45).

14. With regard to claims 185 and 186, Doonan further discloses that the encryption/decryption keys are a shared key generated in accordance with a symmetric key encryption scheme (col. 3, ll. 61-54; col. 9, ll. 48-53).

15. With regard to claims 187 and 188, Doonan further discloses that the encryption/decryption keys may be public/private keys (RSA is a public/private key encryption algorithm)(col. 9, ll. 54-61).

16. With regard to claim 190, AirMobile teaches that the mobile user can also transmit encrypted messages back to the network (p. 26-27). When considered in combination with the above noted teachings of Doonan, the combined references teach and/or suggest a system that system would encrypt any messages sent in reply to a



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related message, transmit those replies back to the redirection server, decrypt the message and send it to the messaging host.

17. Claims 192, 195, 196-198, 201-205, 207, 209, 212-215, 218-222 and 224 are rejected under the same rationale as claims 175, 178, 179-181, 184-188 and 190, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

18. Claims 176, 193 and 210 are rejected under 35 U.S.C. 103(a) as being unpatentable over AirMobile ("AirMobile Software of Lotus cc:Mail Wireless: Communication Server Guide") in view of Doonan et al. (US 6,807,277) further in view of Official Notice.

19. With regard to claim 176, while the system disclosed by AirMobile and Doonan shows substantial features of the claimed invention (discussed above), it fails to disclose establishing a serial connection between the redirector host system and the user's mobile device as the secure communications link.

The Examiner takes Official Notice that serial connections for transferring data between two computers were old and well known in the art at the time the invention was made. One of ordinary skill in the art would have been aware of serial connections and

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would have recognized that a serial connection could have been used as the connection means, for example, when the mobile device is currently stored in a docking station.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a serial connection between the redirector host system and the user's mobile device, since serial connections, when available, are typically less expensive and more secure than wireless connections.

20. Claims 193 and 210 are rejected under the same rationale as claim 176, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

21. Claims 177, 194 and 211 are rejected under 35 U.S.C. 103(a) as being unpatentable over AirMobile ("AirMobile Software of Lotus cc:Mail Wireless: Communication Server Guide") in view of Doonan et al. (US 6,807,277) further in view of Mansour et al. (US 2005/0278641).

22. With regard to claim 177, while the system disclosed by AirMobile and Doonan shows substantial features of the claimed invention (discussed above), it fails to disclose that establishing the secure communications link comprises using Internet Message Access Protocol (IMAP) over Secure Sockets Layer (SSL) protocol.

Mansour teaches that IMAP over SSL allows communications between a server and a client to be "fully encrypted" (§29). Since AirMobile and Doonan use encryption to protect messages in transmission, and IMAP over SSL is a known encryption method, the use of IMAP over SSL in the combined system of AirMobile and Doonan would have been nothing more than a predictable variation of the encryption methods used by that system.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the well known IMAP over SSL protocol to "fully encrypt" messages transmitted between a server and a client.

23. Claims 194 and 211 are rejected under the same rationale as claim 177, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

24. Claims 191, 208 and 225 are rejected under 35 U.S.C. 103(a) as being unpatentable over AirMobile ("AirMobile Software of Lotus cc:Mail Wireless: Communication Server Guide") in view of Doonan et al. (US 6,807,277) further in view of ARDIS ("ARDIS Begins Shipping New Lan-Based E-Mail Software; First Wireless Data Network to Offer Solution for Microsoft Mail and Lotus (sic) cc:Mail Applications; Supports New Motorola Envoy 150 Wireless Communicator").

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25. With regard to claim 191, while the system disclosed by AirMobile and Doonan shows substantial features of the claimed invention (discussed above), it fails to specifically disclose that messages created at either the messaging host system or the mobile device share an electronic address as an originating address (i.e., the "from" address is the same whether the reply was created at the messaging host or the mobile device).

ARDIS discloses a publicly available software application called "Mail on the Run!", and further discloses that the software permitted a user of a mobile device to "wirelessly send, receive, store, forward and reply to messages on their corporate e-mail systems, retaining their LAN mailbox and ID" (p. 2, ¶1). This disclosure would have taught and/or suggested one of ordinary skill in the art to permit e-mail users to reply to messages from a mobile device in the same manner as though they had replied to the message from any other device in their "standard e-mail systems". "[R]etaining their LAN mailbox and ID" would have included using the same "from" address for the message, regardless of the device on which it was created.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the same originating address for a reply data item, regardless of the device on which the message was created since it would have allowed e-mail users to transparently access and use their e-mail from any device attached to the network.

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26. Claims 208 and 225 are rejected under the same rationale as claims 191, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

### ***Conclusion***

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON STRANGE whose telephone number is (571)272-3959. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 571-272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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